

January 20, 2006

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

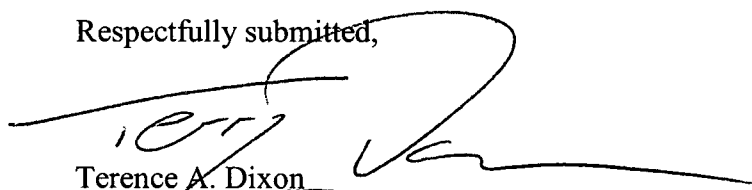
Ref - 2742675

Re: Opposition No. 91167945
Laurice El Badry Rahme Ltd. v. Asprey Holdings Limited

To the Commissioner for Trademarks:

Enclosed are an original and one copy of Applicant/Petitioner's Answer and Counterclaim for filing in the above-referenced proceeding. Please charge the filing fee of \$300 for the counterclaim to Deposit Account No. 04-0475. Any underpayment can be charged, or overpayment credited, to this account.

Respectfully submitted,


Terence A. Dixon

Enclosure

cc: George Gottlieb (w/encl)



01-20-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of Asprey Holdings Limited

Mark: 167 NEW BOND STREET - LONDON - and Design

Serial No.: 76/570,501

Published in the *Official Gazette* of July 12, 2005

LAURICE EL BADRY RAHME LTD
(dba LAURICE & CO.)

Opposer/Registrant

v.

ASPREY HOLDINGS LIMITED

Applicant/Petitioner

Opposition No. 91167945

ANSWER AND COUNTERCLAIM

Applicant/Petitioner, Asprey Holdings Limited, by its attorneys, hereby answers
the numbered paragraphs of the Notice of Opposition as follows:

1. Applicant/Petitioner is without knowledge or information sufficient to
form a belief as to the truth of the allegations in the first numbered paragraph and they are
therefore denied.

2. Applicant/Petitioner admits that it is a corporation organized under the
laws of England and Wales with its headquarters at 167 New Bond Street, London W1S 4AR,
United Kingdom. Applicant/Petitioner otherwise denies the allegations in the second numbered
paragraph as written.

3. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the third numbered paragraph and they are therefore denied.

4. Applicant/Petitioner admits that based on the records of the Patent and Trademark Office, Opposer/Registrant appears to be the owner of record of Registration No. 2,742,675 for the mark BOND NO. 9 but leaves Opposer/Registrant to the proof thereof.

5. Applicant/Petitioner admits that based on the records of the Patent and Trademark Office, Opposer/Registrant appears to be the applicant of record for application Serial No. 76/512,252 and application Serial No. 76/578,912 but leaves Opposer/Registrant to the proof thereof.

6. To the extent that the sixth numbered paragraph is a statement of Opposer/Registrant's intent to rely on its alleged trademark registration and applications and/or common law rights for purposes of this proceeding, no response from Applicant/Petitioner is necessary. Applicant/Petitioner is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations in the sixth numbered paragraph and they are therefore denied.

7. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the seventh numbered paragraph and they are therefore denied.

8. Insofar as Opposer/Registrant's alleged logo designs are apparently based on the design of historic New York City Transit Authority subway tokens, Applicant/Petitioner denies that such logos are "unique." Applicant/Petitioner is otherwise without knowledge or

information sufficient to form a belief as to the truth of the allegations in the eighth numbered paragraph and they are therefore denied.

9. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the ninth numbered paragraph and they are therefore denied.

10. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the tenth numbered paragraph and they are therefore denied.

11. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the eleventh numbered paragraph and they are therefore denied.

12. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the twelfth numbered paragraph and they are therefore denied.

13. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the thirteenth numbered paragraph and they are therefore denied.

14. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the fourteenth numbered paragraph and they are therefore denied.

15. Applicant/Petitioner admits that it is the owner of record of U.S. trademark application Serial No. 76/570,501 for the mark 167 NEW BOND STREET - LONDON - and Design for the goods and services specified therein and that such application was filed on

January 13, 2004 with a claim of priority under Section 44(d) based on a corresponding foreign application that was filed on October 10, 2003. Applicant/Petitioner otherwise denies the allegations in the fifteenth numbered paragraph as written.

16. Applicant/Petitioner admits that the drawing included in the sixteenth numbered paragraph is a representation of Applicant/Petitioner's mark which is the subject of application Serial No. 76/570,501. Applicant/Petitioner also admits that Exhibit B to the Notice of Opposition appears to be a printout from the Patent and Trademark Office's TESS database showing various particulars for application Serial No. 76/570,501.

17. Applicant/Petitioner admits the allegations in the seventeenth numbered paragraph.

18. Applicant/Petitioner denies the allegations in the eighteenth numbered paragraph.

19. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the nineteenth numbered paragraph and they are therefore denied.

20. Applicant/Petitioner denies the allegations in the twentieth numbered paragraph.

21. Applicant/Petitioner admits that the mark which is the subject of application Serial No. 76/570,501 and apparently at least some of Opposer/Registrant's alleged marks include the term "Bond." Applicant/Petitioner otherwise denies the allegations in the twenty-first numbered paragraph.

22. Applicant/Petitioner admits that its mark which is the subject of application Serial No. Serial No. 76/570,501 contains the term "London" and that

Opposer/Registrant's alleged mark BOND NO. 9 NEW YORK (stylized) contains the term "New York" and apparently other alleged marks of Opposer/Registrant contain the term NEW YORK, the abbreviation "NYC" and/or references to neighborhoods or other geographic locations in or around New York City. Applicant/Petitioner otherwise denies the allegations in the twenty-second numbered paragraph as written.

23. Applicant/Petitioner admits that its mark which is the subject of application Serial No. 76/570,501 includes a circular logo design element and that apparently at least some of Opposer/Registrant's alleged marks also include a circular logo design element. Applicant/Petitioner otherwise denies the allegations in the twenty-third numbered paragraph as written.

24. Applicant/Petitioner denies the allegations in the twenty-fourth numbered paragraph.

25. Applicant/Petitioner denies the allegations in the twenty-fifth numbered paragraph.

26. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the twenty-sixth numbered paragraph and they are therefore denied.

27. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the twenty-seventh numbered paragraph and they are therefore denied.

28. Applicant/Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in the twenty-eighth numbered paragraph and they are therefore denied.

29. Applicant/Petitioner denies the allegations in the twenty-ninth numbered paragraph.

COUNTERCLAIM FOR CANCELLATION

Applicant/Petitioner, by its attorneys, hereby counterclaims to petition to cancel Opposer/Registrant's Registration No. 2,742,675.

The grounds for cancellation are as follows:

1. On February 28, 2001, Opposer/Registrant filed an intent-to-use application under Section 1(b) of the Trademark Act to register the mark BOND NO. 9 on the Principal Register. The application was designated Serial No. 75/981,311.

2. A Notice of Allowance for application Serial No. 75/981,311 covering "fragrances, namely, perfumes, colognes and room fragrances" in Class 3 and "clothing, namely, dresses, skirts, pants, blazers, scarves and neckties" in Class 25 was issued on October 8, 2002.

3. On March 24, 2003, Opposer/Registrant filed a Statement of Use Under 37 CFR 2.88, with Declaration for application Serial No. 75/981,311 alleging use of the mark in commerce for "[t]hose goods/services identified in the Notice of Allowance in this application." The Statement of Use alleged use in commerce since at least as early as October 28, 2002 for the goods in Class 3 and at least as early as December 31, 2002 for the goods in Class 25. The declaration was signed by Laurice Rahme, President of Opposer/Registrant, and was dated March 19, 2003. The Statement of Use was submitted by counsel for Opposer/Registrant in this proceeding.

4. A registration on application Serial No. 75/981,311 subsequently issued on July 29, 2003 as Registration No. 2,742,675.

5. On August 9, 2005, Opposer/Registrant filed its initial Request for an Extension of Time to Oppose Applicant/Petitioner's application Serial No. 76/570,501.

6. On September 1, 2005, Opposer/Registrant filed an Application for Amendment of Registration Under C.F.R. Section 2.173 with respect to Registration No. 2,742,675. That filing requested that Registration No. 2,742,675 be amended "by deleting Class 25 in its entirety from the identification of goods in the Registration so that the Registration is limited solely to Class 3." The declaration contained within that filing was signed by Laurice Rahme, President of Opposer/Registrant, and dated August 29, 2005. The Application for Amendment of Registration was submitted by counsel for Opposer/Registrant in this proceeding.

7. On information and belief, as of March 19, 2003, Opposer/Registrant was not using the mark BOND NO. 9 in commerce on all of the Class 25 goods specified in the Notice of Allowance for application Serial No. 75/981,311.

8. On information and belief, as of March 19, 2003, Opposer/Registrant was not using the mark BOND NO. 9 in commerce on any of the Class 25 goods specified in the Notice of Allowance for application Serial No. 75/981,311.

9. On information and belief, Opposer/Registrant has never used the mark BOND NO. 9 in commerce on all of the Class 25 goods specified in the Notice of Allowance for application Serial No. 75/981,311

10. On information and belief, Opposer/Registrant has never used the mark BOND NO. 9 in commerce on any of the Class 25 goods specified in the Notice of Allowance for application Serial No. 75/981,311.

11. On information and belief, Opposer/Registrant submitted a false Statement of Use for Serial No. 75/981,311.

12. Opposer/Registrant's submission of a false Statement of Use for Serial No. 75/981,311 constitutes fraud on the Patent and Trademark Office. Such fraud renders any resulting registration *void ab initio* in its entirety and cannot be cured by the subsequent deletion of goods from the registration.

13. Opposer/Registrant submitted its Application for Amendment of Registration Under C.F.R. Section 2.173 with respect to Registration No. 2,742,675 after it filed its initial Request for an Extension of Time to Oppose Applicant/Petitioner's application Serial No. 76/570,501. On information and belief, Opposer/Registrant submitted its Application for Amendment of Registration Under C.F.R. Section 2.173 with respect to Registration No. 2,742,675 in anticipation of filing a Notice of Opposition against Applicant/Petitioner's application Serial No. 76/570,501.

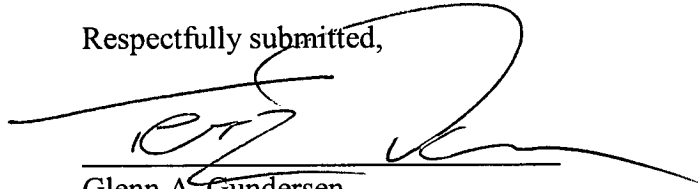
14. Opposer/Registrant's continued registration of BOND NO. 9 pursuant to Registration No. 2,742,675 would provide Opposer/Registrant with conclusive evidence that it owns the mark and has the exclusive right to use that mark in connection with the Class 3 goods currently specified in that registration. Opposer/Registrant has asserted its alleged rights in Registration No. 2,742,675 as a basis for opposing Applicant/Petitioner's application in this proceeding, thus causing injury and damage to Applicant/Petitioner.

15. Since Opposer/Registrant secured the registration fraudulently, Registration No. 2,742,675 should be cancelled in its entirety pursuant to Section 14(3) of the Trademark Act.

WHEREFORE, Applicant/Petitioner Asprey Holdings Limited prays that this Opposition be dismissed with prejudice, that Registration No. 2,742,675 be cancelled, and that

the registration of the mark shown in Applicant/Petitioner's application Serial No. 76/570,501 be granted.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Gundersen', is written over a horizontal line.

Glenn A. Gundersen

Terence A. Dixon

DECHERT LLP

Cira Centre

2929 Arch Street

Philadelphia, PA 19104-2808

(215) 994-4000

Attorneys for Applicant/Petitioner,
Asprey Holdings Limited

Dated: January 20, 2006

CERTIFICATE OF MAILING

I hereby certify that this Answer and Counterclaim is being deposited with the United States Postal Service as Express Mail, Post Office to Addressee, in an envelope addressed to: Commissioner of Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on January 20, 2006.

Terence A. Dixon

Person Signing Certificate


Signature

January 20, 2006

Date of Signature

ET808607005US

Express Mail Number

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Answer and Counterclaim has been duly served by mailing such copy first class, postage prepaid, to George Gottlieb, Esq., GOTTLIEB, RACKMAN & REISMAN, P.C., 270 Madison Avenue, New York, New York 10016-0601, on January 20, 2006.


Terence A. Dixon